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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/662,429	09/16/2003	Steven M. Ruben	1488.1890003	2663

28730 7590 07/25/2005

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.
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WASHINGTON, DC 20005

EXAMINER

HUYNH, PHUONG N

ART UNIT PAPER NUMBER

1644

DATE MAILED: 07/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.



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KIRKPATRICK & LOCKHART NICHOLSON GRAHAM LLP (FORMERLY KIRKPATRICK & LOCKHART LLP) 75 STATE STREET BOSTON, MA 02109-1808			HUYNH, PHUONG N	
			ART UNIT	PAPER NUMBER
			1644	

DATE MAILED: 07/05/2005

Resmold

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/662,429	RUBEN, STEVEN M.	
	Examiner	Art Unit	
	Phuong Huynh	1644	

- The MAILING DATE of this communication appears on the cover sheet with the correspondence address -

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE Three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.138(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-10, 12-15, 17, 25, 27 and 30-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 10, 12-15, 17, 25, 27 and 30-38 is/are allowed.
- 6) ☒ Claim(s) 8 and 9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4/1/05</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 8-10, 12-15, 17, 25-, 27 and 30-38 are pending.
2. The request filed 4/1/05 for interference with a patent pursuant to 37 C.F.R. § 41.202(a) is acknowledged. However, amended claims 8 and 9 are still not in condition for allowance.
3. The declarations and unpublished applications on PTO 1449, filed 4/1/05 have been considered but crossed out because said declarations and unpublished applications are not appropriate to be printed on an issued patent.
4. In view of the amendment filed 4/1/05, the following rejection remains.
5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
6. Claims 8 and 9 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention.

The specification does not reasonably provide a written description of any purified protein consisting of at least any 30 or 50 contiguous amino acids of SEQ ID NO: 2 for treating all disease such as any autoimmune disease, any lymphadenopathy, and graft versus host disease.

The specification discloses only a purified protein from human comprising amino acids 1 to 281 of SEQ ID NO: 2 encoded by the deposited human cDNA, and a soluble protein comprising amino acids 39 to 281 of SEQ ID NO: 2 for radioimmune assay or binding assays. The specification discloses compositions comprising AIM-I polypeptide intended for treatment of autoimmune disease, graft versus host disease, lymphadenopathy and among other things (pages 3-6).

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Other than the specific purified protein encoded by the deposited cDNA mentioned above, there is inadequate written description about the function associated with any purified protein consisting of at least any 30 or 50 contiguous amino acids of SEQ ID NO: 2.

The specification discloses only one polypeptide comprising SEQ ID NO: 2 that encoded by the human cDNA contained in ATCC Deposit No 97448 that induces apoptosis in T cells, one of skill in the art would reasonably conclude that the disclosure fails to provide a representative number of species purified protein consisting of at least 30 or 50 contiguous amino acids of SEQ ID NO: 2 to describe the genus. Thus, Applicant was not in possession of the claimed genus. *See University of California v. Eli Lilly and Co.* 43 USPQ2d 1398; *University of Rochester v. G.D. Searle & Co.*, 69 USPQ2d 1886 (CA FC2004).

Applicant is directed to the Final Guidelines for the Examination of Patent Applications Under the 35 U.S.C. 112, ¶ 1 "Written Description" Requirement, Federal Register, Vol. 66, No. 4, pages 1099-1111, Friday January 5, 2001.

Applicants' arguments filed 4/1/05 have been fully considered but are not found persuasive.

Applicants' position is that claims 8 and 9 have been amended. Based on the well-characterized sequence conservation within the TNF ligand family, one of skill in the art could recognize and clearly envision sequences of SEQ ID NO: 2 that would have apoptotic activity (see Exhibit A).

In response, applicant appears to argue for enablement, not written description. Note, amending claims 8 and 9 to include functional language would obviate this rejection.

7. Claims 10, 12-15, 17, 25, 27 and 30-38 are allowed.

8. **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for response to this final action is set to expire **THREE MONTHS** from the date of this action. In the event a first response is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed

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until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for response expire later than SIX MONTHS from the date of this final action.


9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phuong Huynh "NEON" whose telephone number is (571) 272-0846. The examiner can normally be reached Monday through Friday from 9:00 am to 5:30 p.m. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on (571) 272-0841. The IFW official Fax number is (571) 273-8300.
10. Any information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Phuong N. Huynh, Ph.D.

Patent Examiner

Technology Center 1600

June 24, 2005


CHRISTINA CHAN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600